

REMARKS

Claims 1 - 7 remain active in this application. Claim 1 has been amended to answer a criticism by the Examiner and further clarify cooperation of claimed elements. Support for the amendments of the claims is found throughout the application, particularly on page 5 at line 21+. No new matter has been introduced into the application.

The Examiner has objected to claim 1 for inexact antecedent language correspondence. This objection is respectfully traversed as being moot in view of the amendments made above; adopting the Examiner's suggestion. Accordingly, reconsideration and withdrawal of this objection is respectfully requested.

Claims 1 - 7 have again been rejected under 35 U.S.C. §103 as being unpatentable over Toba in view of Colonna et al. This ground of rejection is again respectfully traversed for the reasons of record and the further remarks provided below.

It is respectfully submitted that, under 35 U.S.C. §103, as well as 35 U.S.C. §102, all recitations of the claims must be answered. However, under 35 U.S.C. §103, the Examiner may rely on the combined teachings and/or suggestions of the references applied, together with motivation for their combination, or evidence therein of the level of ordinary skill in the art which would support a conclusion of obviousness of any differences that may remain. It is Applicant's position that the Examiner has not shown the applied references to answer all the recitation of the claims and thus has not made a *prima facie* demonstration of obviousness in regard to any claim in the application. Essentially, the Examiner appears to have taken the position that, if two different control functions can be controlled by folding phone configuration, control of any other function would be obvious even in the

absence of any suggestion of the alternative function. It is respectfully submitted that such a position is not well-taken and, moreover, indicates the utilization of impermissible hindsight as well as failing to make a *prima facie* demonstration of obviousness of the subject matter actually claimed.

Specifically, even if, *arguendo*, Toba and Colonna et al contain all the teachings attributed thereto by the Examiner, the fact remains that Toba, while controlling display of a *missed* call indication by either an LED on the exterior of a folding phone when the folding phone is folded or by an LCD display only visible when the folding phone is in an unfolded condition, has nothing to do with controlling how a user is informed of an *incoming* call by a sounder or a vibrator depending on whether the folding phone is folded or unfolded. This fact is particularly evident when it is considered that a missed call will presumably occur only when the user is absent or separated from the folding phone and the question of a preferred mode of notification of the user of the existence of an incoming call is not presented.

Colonna et al. while arguably slightly closer to the invention, conceptually, than Toba because the user is necessarily present and the controlled function relates to audibility, switches between a speaker phone mode, a private mode and a standby mode based on relative positions of parts of a folding phone which also has little, if anything, to do with different modes of notification of a user of an incoming call, as is the function of the present invention. The invention also has particular utility relative to Toba and Colonna et al. since, while a user will consciously reconfigure a folding phone to allow optimum audibility an sound pick-up depending on whether speaker phone mode operation or private mode operation is desired, the same cannot be said in regard to incoming call

notification relative to placement of the folding phone on a desktop, in a pocket or the like where there is a greater need for automatic operation *without* conscious control by a user.

That is, when a folding phone is moved from a desktop to a pocket or vice-versa, together with reconfiguration of the folding phone appropriate to such a change of location, the invention provides for change of mode of notification of the user of an incoming call appropriate to the location of the folding phone without conscious action by the user to alter the notification mode of the folding phone which the user is unlikely to provide, particularly through key actuation as is generally required in the absence of the meritorious function provided by the invention. Therefore, it is evident that the references relied upon not only fail to answer the claim recitations regarding the incoming call notification mode but the problems addressed therein are not remotely parallel or analogous to the problems addressed by the invention: to switch between incoming call notification modes automatically based upon the likely usual configuration of a folding phone in different locations having different properties in regard to the sensory perceptibility of sound and vibration between those locations. By the same token, the prior art relied upon can provide no evidence in regard to the level of ordinary skill in the art in regard to the production of such a function in response to an unconscious action by the user and certainly do not provide such evidence as could possibly support a conclusion of obviousness as the Examiner has asserted.

Moreover, as previously pointed out, the Examiner has failed to demonstrate that the prior art answers explicitly recited elements of the invention or their cooperation. Claim 1 clearly recites both a controller (16) and a main controller (20) which are clearly

disclosed and thus defined in the claims to be different elements. While it is conceded that Toba discloses control of which of a sounder or vibrator or both may be used to notify a user of an incoming call, that control is clearly exercised through the equivalent of a main controller as is evident from Figure 3 and the description thereof on pages 8 and 9 of Toba. In sharp contrast and as specifically and explicitly recited in the claims, the invention removes this function from the main controller (20) to the controller (16) which is only responsive to the main controller in regard to an incoming call signal but independently controls the sounder or vibrator responsive only to the two-level switch. It is also believed significant in this regard that the control of standby, private and speaker phone modes is also clearly performed in Colonna et al. through the equivalent of a main controller rather than a separate controller. Thus, although transparent to a user, the invention provides for a reduction of control functions of the main processor which may be significant in volume if the mode of incoming call notification is frequently changed. The prior art relied upon provides no teaching or suggestion of removing any particular control functions from the main controller to a separate controller, much less the incoming call notification mode control, as claimed and now further emphasized by the above amendment to claim 1, and the Examiner's discussion of the ground of rejection is silent in regard to this distinguishing feature of the invention as compared to the prior art relied upon.

Accordingly, it is clearly seen that the asserted ground of rejection is in error and unsupported by the prior art relied upon. The Examiner has not made and cannot make a *prima facie* demonstration of obviousness of any claim in the application based on Toba and Colonna et al. Moreover, the Examiner's position

clearly reflects the utilization of impermissible hindsight and fails to properly consider explicit recitations of the claims as to overall function and particular claimed elements and their cooperation. Further, modification of either or both of the applied references to answer these claim recitation would preclude operation thereof, alone or in combination, in the intended manner since a two-level switch can only be used for control of a single function at a time and the references, if modified to provide configuration responsive control of incoming call notification mode, would be incapable of providing missed call notification control or operational (e.g. standby, private or speaker phone) mode. See *In re Gordon*, 221 USPQ 1125 (Fed. Circ., 1984).

In view of the foregoing, it is respectfully submitted that the asserted ground of rejection is improper, in error, unsupported by the content of the references applied and thus untenable while no *prima facie* demonstration of obviousness has been made in regard to any claim in the application. Explicitly claimed subject matter has either been ignored or accorded no patentable weight and without comment or stated rationale by the Examiner. Accordingly, reconsideration and withdrawal of the ground of rejection based on *Toba* and *Colonna et al.* is respectfully requested.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Marshall M. Curtis".

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